

Appl. No. 10/730,438
Attr. Docket No. CM2713Q
Amdt. dated May 7, 2007
Reply to Office Action of February 5, 2007
Customer No. 27752

REMARKS

Claim Status

Claims 1 – 9 are pending in the present application. No additional claims fee is believed to be due.

Claim 9 has been amended to correct a typographical error.

Rejection Under 35 USC §102 Over Noda

Claims 1 and 2 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. No. 6,949,689, issued to Noda, *et al.*, (hereinafter “Noda”). Applicants respectfully traverse the rejection.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants submit that Noda does not teach each and every element recited in claim 1 of the present application.

Claim 1 recites, *inter alia*, said polymeric film and said nonwoven web both comprise a polymeric material, at least one of said polymeric materials of said film or of said nonwoven web is colored by pigments comprised within said polymeric material. With regard to pigments comprised within said polymeric material, the present application states “the coloring agent used to color-pigment the nonwoven web and/or polymeric film . . . is added before melting the thermoplastic material comprised by the nonwoven web and/or polymeric film.” (The present application page 9, lines 1 – 5). Thus, one of ordinary skill in the art would appreciate that the polymeric material comprises the pigment before it is melted to form a web or film.

In contrast, Noda states “[t]he pattern 10 is printed on the exterior side of the breathable film 3a on which the first nonwoven material 3b is to be superposed. (Noda, col.4, lines 12 – 14). Clearly, the pigment referred to in Noda is an ink applied to the film after it is already formed, and not comprised within the polymeric material, as

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recited in claim 1 of the present application. In fact, Applicants are unable to find any disclosure in Noda of a polymeric web or film colored by pigments comprised within the polymeric film, as is recited in claim 1 of the present application. Additionally, the Office Action does not point to the particular part of Noda relied upon to support a teaching of a polymeric web or film colored by pigments comprised within the polymeric film, as is required under 37 CFR §104(c)(2).

Further, Applicants would like to point out that claim 1 recites, *inter alia*, an L Hunter value from 10 to 75, an "a" value from about -50.0 to about +50.0 and a "b" value from about -50.0 to about +50.0 **in the areas outside the printed ornamental designs**. In contrast, Noda states "it has been ascertained that the pattern 10 can be seen clearly through nonwoven material . . . when the **printed area** has an L* value of 10 to 93" (Noda, col. 4, lines 30 - 34, emphasis added). Thus, Applicants submit that Noda actually teaches away from the claims of the present application.

In light of the above remarks, Applicants submit that Noda does not teach each and every element recited in claim 1 of the present application. Claim 2 depends from claim 1, and therefore Noda does not teach each and every element of claim 2 for the same reasons. Accordingly, Applicants respectfully request the rejection of claims 1 and 2 under 35 U.S.C. 102(e) be reconsidered and withdrawn.

Rejection Under 35 USC §103 Over Tao in View of Rogers

Claims 1 and 3 - 7 have been rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Pub. No. WO99/32164, filed by Tao, *et al.*, (hereinafter "Tao") in view of U.S. Pat. No. 5,133,707, issued to Rogers, *et al.*, (hereinafter "Rogers") Applicants respectfully traverse the rejection.

In order to make out a *prima facie* case of obviousness, three requirements must be met. First, there must be some suggestion or motivation to combine the sources, second, there must be a reasonable expectation of success and lastly, the prior art references must teach or suggest all the claimed limitations of the present invention. (MPEP §2143). Applicants submit that the combination of Tao in view of Rogers does not teach or suggest each and every element recited in claim 1 of the present application.

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Applicants also submit that there is no motivation to combine Tao and Rogers, and therefore such combination is improper.

Claim 1 recites, *inter alia*, said polymeric film being joined in an overlaying region across at least part of one of its major surfaces to at least part of an adjacent major surface of said nonwoven web to form said backsheet and wherein said backsheet in said overlaying region has a L Hunter value on the Hunter scale for darkness/lightness-appearance from 10 to 75, an "a" value for red/green-appearance from about -50.0 to about +50.0 and an "b" value for yellow/blue-appearance from about -50.0 to about +50.0 in the areas outside the printed ornamental designs. The Office Action, however, does not point to the particular part of Tao or Rogers relied upon to support a teaching or suggestion of a backsheet comprised of a nonwoven web and a polymer film joined in an overlaying region wherein the backsheet in the overlaying region has the L Hunter value recited in claim 1 of the present application, as is required under 37 CFR §104(c)(2).

Additionally, it is Applicants position that since the Office Action has not shown where in Tao or Rogers there is a teaching or suggestion of each and every element recited in claim 1 of the present application, the combination cannot be said to disclose a product that is identical or substantially identical in structure to the disposable article recited in claim 1 of the present application. Therefore, absent any evidence to the contrary, Applicants submit that the Office Action has not made a *prima facie* case of obviousness under the holding of *In re Best*, as asserted in the Office Action. (*In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977), The Office Action, page 3 - 4).

A "proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference." (MPEP §2143.01). In the present case, Applicants submit that the modification of Tao in view of Rogers as proposed by the Office Action is contrary to the disclosure of Tao and would render Tao unsatisfactory for its intended purpose.

Tao states "[i]t has also been found that a **high degree of whiteness . . .** is very important to the consumer." (Tao, page 2, lines 23 - 25, emphasis added). Tao also states "[i]t is believed that **any such yellow shade is highly unacceptable** to consumers, who tend to prefer a **bright, intense white appearance.**" (Tao, page 4, lines 15 - 17,

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emphasis added). In an example that "describes and demonstrates a preferred embodiment of the microporous polymer film" of Tao, the L-Hunter value is disclosed as 93.46. (Tao, page 12, lines 21 - 22; Tao, middle of page 13). Tao states that "'L' is a measure of the lightness of a sample ranging from L=0 (blackness) to L=100 (whiteness). As best understood by Applicants, Tao is disclosing that an L-value as close to 100 as possible is desirable for the polymer film of Tao.

Contrary to the express disclosure in Tao, however, the Office Action proposes a modification that would lower the L-value of the polymer film of Tao to fall within the range recited in claim 1 of the present application. Thus, it is Applicants' position that one of ordinary skill in the art would not be motivated to modify the film of Tao with the disclosure of Roger due to the teachings away from such a modification by Tao. Therefore, Applicants submit that such a modification is improper under MPEP §2143.01.

In light of the above remarks, Applicants respectfully submit that the Office Action has failed to make a *prima facie* case of obviousness with regard to claim 1 or any claims depending from claim 1. Accordingly, Applicants respectfully request that the obviousness rejection of claims 1 and 3 - 7 over Tao in view of Rogers be reconsidered and withdrawn.

Rejection Under 35 USC §103 Over Tao in View of McCormack

Claim 2 has been rejected under 35 U.S.C. §103(a) over Tao in view of Intl. Pub. No. WO00/38915, filed by McCormack, *et al.*, (hereinafter "McCormack"). Applicants respectfully traverse the rejection.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

The Office Action states "Tao does not expressly disclose opacity values." (The Office Action, page 4). The Office Action goes on to state "it would be obvious for one of ordinary skill in the art at the time the invention was made to modify Tao with the

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opacity . . . [of McCormack?].” (The Office Action, page 4). Applicants are unable to find a statement in the Office Action explaining how the opacity of Tao is to be modified, and where in McCormack the proposed modification is located. Since neither Tao nor McCormack actually disclose an opacity value, the combination cannot teach or suggest each and every element recited in claim 2 of the present application.

The Office Action goes on to state that “[o]pacity is a well known result-effective variable that results in an improved color contrast for masking purposes as supported by McCormack.” (The Office Action, page 4). As best understood by the Applicants, the portion of McCormack cited to support the Office’s assertion is directed to improving color contrast between two microporous film layers. (Id). The law is well settled that “[a] particular parameter must first be recognized as a result-effective variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” MPEP §2144.05(II)(B) citing *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). In the case of *In re Antonie*, the prior art did not recognize a particular parameter and therefore the parameter optimized was not recognized in the art to be a result-effective variable. *Id.* Likewise in the instant case, neither Tao nor McCormack recognize the parameter of opacity (as recited in claim 2 of the present application) as evidenced by the lack of any measured values for opacity. Thus, Applicants submit that opacity cannot be said to be a result-effective variable.

In addition to a lack of teaching or suggestion of each and every element of claim 2 of the present application by the combination of Tao and McCormack, Applicants submit that McCormack actually teaches away from Tao. Tao clearly discloses that an off-white colored film is highly unacceptable to consumers, and that consumers tend to desire films with a bright intense white appearance. (Tao, page 2, lines 25 – 26; page 4, lines 15 – 18). Tao further states “the most important parameter for the films of the present invention is the “b” value, due to the lack of consumer acceptance of yellowish (i.e., off-white) films . . . the b value for the films of the present invention is . . . more preferably as close to zero as possible.” (Tao, page 5, lines 9 – 14). In stark contrast, McCormack discloses a multilayer film wherein either of the layers may comprise a **dark**

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layer. (McCormack, page 8, lines 20 – 21). Further, McCormack states “when a first layer is desired having a light appearance (e.g., white, **off-white** and so forth) it is desirable” (McCormack, page 8, lines 5 – 6). Clearly, a dark or off-white color film is acceptable for use with McCormack, which is completely contrary to the disclosure of Tao.

In light of the above remarks, it is Applicants’ position that the Office Action has not made a *prima facie* case of obviousness, and further that the combination of Tao and McCormack is improper. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection Under 35 USC §103(a) Over Tao in view of Schleinz et al.

Claims 8 – 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tao in view of U.S. Pat. No. 5,612,188, issued to Schleinz, *et al.*, (hereinafter “Schleinz”). Applicants respectfully traverse the rejection.

The Office Action states “Tao does not expressly disclose a half-toning printing process in which one of the surfaces . . . is covered with an opaque or transparent ink while a second area is covered with the same ink.” (The Office Action, page 4). The Office Action cites Schleinz for disclosure directed to a training pant having . . . a plurality of graphics . . . said graphics using a semi-tone/half-toning process on two different areas of the composite outer cover in order to eliminate blurred or ghost graphics.” (Id). Applicants respectfully disagree with the Office’s reading of Schleinz.

As best understood by Applicants, Schleinz is directed to a printing process for printing **semi-tone graphics** (as opposed to a halftone printing process) on a gatherable substrate and when the substrate is gathered the graphics appear as full-tone graphics. (Schleinz, abstract; col. 2, lines 10 – 17). Schleinz states “semi-tone graphic refers to a graphic that has been printed with an amount of ink less than a predetermined amount of ink required for a full-tone graphic.” (Schleinz, col. 6, lines 16 – 18). Schleinz also states “a full tone graphic refers to a graphic that has been printed with a predetermined amount of ink that results in the desired definition, resolution, tone, color intensity, or the like.” (Schleinz, col. 6, lines 14 – 16).

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In contrast to Schleinz, the present application states with regard to a halftone printing process

When a single color is applied on a white surface, it is possible to vary the intensity of this color e.g. by varying the add-on level of color per surface area (e.g. by **varying the density of ink dots per surface area in a halftone process**). It is thus possible to produce different shades of one color. It is, however, not possible to produce the effect of an additional second color by varying the add-on level on white surfaces.

Contrary, in the present invention it is possible to produce the effect of additional colors due to the color-pigmented surface whereon the ornamental designs are printed. For example, when non-transparent, opaque blue ink is printed on a yellow surface without covering the whole surface (e.g. by **allying small, discrete dots in a halftoning-process**), then such treated surface will be visually perceived as being green.

(The present application, page 11, lines 23 – 33, emphasis added). Applicants submit that Schleinz does not teach or suggest the halftoning printing process for which it is cited.

It is Applicants' position that one of ordinary skill in the art would appreciate that Schleinz does not expressly disclose a halftone printing process (e.g., allying small discreet dots of ink on the surface of a substrate in various densities), as is recited in claim 8 of the present application. Rather, Applicants submit that one of ordinary skill would understand Schleinz to disclose a gatherable substrate having an elongated semi-tone graphic applied thereto such that when the substrate is gathered, resultant changes in the visual characteristics of the semi-tone graphic provide the appearance of a full-tone graphic. Applicants, however, are unable to find any teaching or suggestion in Schleinz that the density of the ink dots per surface area is, in fact, varied. Applicants would like to point out that while a substrate (such as the gatherable substrate of Schleinz) may contain elevated portions and unelevated portions when in a gathered configuration, the total surface area remains unchanged from the ungathered configuration, and therefore the density of ink (or ink dots) per surface area also remains the same.

Notwithstanding the above remarks, Applicants are unable to find any statement in the Office Action or any disclosure in Tao or Schleinz directed to printing which is applied such that **the effect of an additional color is created** by covering at least a first area of at least one of said major surfaces of at least one of said polymeric film or said nonwoven web with opaque ink in a halftoning process while covering at least a second

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area completely with the same ink, as is recited in claim 8 of the present application. Absent such teaching or suggesting, Applicants submit that Tao in view of Schleinzi does not teach or suggest each and every element of claim 8 of the present application.

With regard to claim 9, Applicants are unable to find any disclosure in Tao or Schleinzi that teaches or suggests printing that is applied such that the effect of an additional color is created by covering at least a first area of at least one of said major surfaces of at least one of said polymeric film or said nonwoven web with a relatively thin layer of a transparent ink while applying a relatively thick layer of the same ink in at least a second area, as is recited in claim 9 of the present application. Since the Office Action fails to point to the particular part of Tao and/or Schleinzi relied upon to teach or suggest each and every element of claim 9, as required under 37 CFR §104(c)(2), Applicants respectfully submit that the rejection is improper.

In light of the above remarks, it is Applicants' position that the Office Action has failed to make a *prima facie* case of obviousness. Accordingly, Applicants respectfully request that the rejection of claims 8 and 9 under 103(a) be reconsidered and withdrawn.

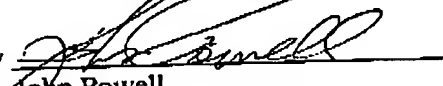
Conclusion

This amendment represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. Applicant respectfully requests that the rejection of the claims be reconsidered in light of the claim amendment and arguments set forth herein and that claims 1 - 9 be allowed. Early and favorable action in the case is respectfully requested.

Respectfully submitted,

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